

REMARKS

Reconsideration and withdrawal of the rejections to the claims set forth in the Office Action of June 10, 2008 are respectfully requested in view of the following remarks.

Status of the claims

Claims 1-14 are pending.

Claims 6-14 stand withdrawn from consideration.

Claims 1-5 stand rejected under 35 U.S.C. § 102.

Claims 1-2 have been canceled without prejudice.

Claims 3-5 have been amended.

New claim 15 has been presented for examination.

Objection to the Specification

The Examiner has objected to the Abstract of Disclosure as lacking process steps. Applicant has included amended the Abstract to overcome the Examiner's objection. Withdrawal of the objection is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1-5 under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art or U.S. Patent No. 5,810,992, in view of: U.S. Patent No. 6,045,860 (for claim 1), JP 57-169097 (for claim 2), JP 03-068776 (for claim 3), JP 57-169097

(for claim 4), or JP 06-159131 (for claim 5). Reconsideration and withdrawal of the rejections are respectfully requested based on the following remarks.

Applicant has canceled claims 1 and 2 rendering the rejections to those claims moot.

Applicant has amended claim 3 to include all of the limitations of base claims 1 and 2.

Amended claim 3 is directed to a method of applying metal plating to a cylinder of an internal combustion engine. The method includes filling the cylinder with a plating solution, and permitting the plating solution to pass through and along the axial line of the cylinder, thereby permitting a layer of electroless plating to be deposited on an inner circumferential surface of the cylinder. Claim 3 contains the limitation “a predetermined quantity of the plating solution is introduced from a main tank into a subtank disposed over the cylinder and then, the plating solution is permitted to gravitationally drop into the cylinder from the subtank, thereby filling the cylinder with the plating solution, the plating solution being subsequently permitted to pass through the interior of the cylinder and to return to the main tank.”

The Examiner admits that neither Applicant’s admitted prior art nor U.S. Patent No. 5,810,992 contains a teaching that the plating solution is supplied in the manner claimed in the instant application, yet asserts that claim 3 is unpatentable in view of JP 03-068776 (“the ‘776 reference). Applicant respectfully disagrees.

The ‘776 reference describes an electroless plating method. The ‘776 reference teaches mixing a metal ion solution and a reducing agent solution (in containers 1 and 2 respectively) in a container 7 accommodating a material to be plated while allowing the solutions to continuously drop thereinto. (The ‘776 reference, Abstract). This allows the reaction to take place and the reacted solution is continuously discharged from container 7. (*See id.*) However, the ‘776 reference lacks a teaching or suggestion of “a predetermined quantity of the plating solution is

introduced from a main tank into a subtank disposed over the cylinder and then, the plating solution is permitted to gravitationally drop into the cylinder from the subtank, thereby filling the cylinder with the plating solution, the plating solution being subsequently permitted to pass through the interior of the cylinder and to return to the main tank.” Instead the ‘776 reference merely discloses allowing a plating solution in a tank to continuously drop into a container accommodating a material to be plated. There is no disclosure of the plating solution passing through the interior of a cylinder to return to a main tank.

Thus, the ‘776 reference does not disclose or suggest, either alone or in combination with other references of record, the method of applying metal plating to a cylinder of an internal combustion engine defined by claim 3. In view of the complete absence of this claim limitation in the ‘776 reference, and thus the fact that the ‘776 reference does not disclose or suggest each and every element of claim 3, Applicant submits that claim 3 is patentable over the cited references.

Claims 4-5 which are dependent on claim 3 are similarly patentable over the ‘776 reference.

JP 57-169097 and JP 06-159131 have not been cited for the teaching of the aforementioned limitation missing from the prior art. Accordingly, the rejection to claims 3-5 should be withdrawn and claims 3-5 should be allowed.

New Claim

Applicant has presented new claim 15 for examination.

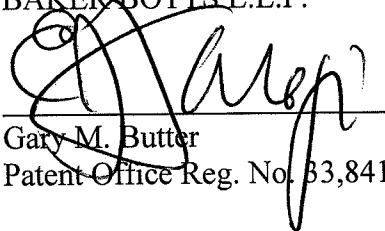
Conclusion

In view of the foregoing, the application is now believed to be in condition for formal allowance. Prompt and favorable action is respectfully requested. Applicant does not believe that any additional fee is required in connection with the submission of this document. However, should any additional fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377.

Respectfully submitted,

BAKER-BOTTS L.L.P.

By:



Gary M. Butter
Patent Office Reg. No. 33,841

Eric J. Faragi
Patent Office Reg. No. 51,259

30 Rockefeller Plaza
New York, NY 10012-4498
Attorneys for Applicants

212-408-2500